

REMARKS

By this Amendment, claims 3, 8, 10, 11 and 12 have been amended, and claims 7 and 21 have been cancelled. Accordingly, claims 3, 4, 6, 8, 10, 11 and 12 are pending in the present application.

The objection to the drawings is noted. In response, claim 21 has been cancelled. Accordingly, this rejection is deemed moot.

Claims 3, 6-8, 10-12 and 21 stand rejected under 35 U.S.C. § 112, first paragraph. In particular, the Examiner has stated that the language “substantially equal in thickness” within the claims is new matter. In response, Applicants have amended the independent claims to remove this language. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 3, 6 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithgow or Isoda in view of Ishikawa, et al. (JP ‘804). This rejection is deemed moot with respect to claim 21 due to its cancellation. Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithgow or Isoda in view of Hidaka, et al. (U.S. ‘091). Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithgow or Isoda in view of Ishikawa, et al. (JP ‘804) or Hidaka (U.S. ‘091) and further in view of Fukazawa (JP ‘448). Applicants respectfully traverse these rejections with respect to claims 3, 4 and 6.

Among the limitations of independent claim 3 which are neither disclosed nor suggested in the prior art of record is a coaxial resonator which includes “a non-conducting element disposed between the columnar element and the dielectric element”, and “wherein a thickness of the conductor layers and a thickness of the dielectric layers are based on the non-conducting element”. Support for this amendment can be found in the specification from page 13, line 5 to page 14, line 9.

The non-conducting element of the present invention between the columnar element and the dielectric element has not been taken into consideration when the thickness of the conductor layers and the thickness of the dielectric layers are determined. In fact, it has been believed by those of skill in the art that a multi-layer electrode cannot have a low-loss characteristic when a non-conducting element is placed between a columnar element and dielectric element. None of the cited references, either alone or combined, teach this limitation.

As admitted on page 7 of the Office Action, neither Lithgow nor Isoda, either alone or combined, teach or suggest that a non-conducting element can be disposed between the columnar element and the dielectric element.

Neither Ishikawa, et al. nor Hidaka, et al. remedy any of the deficiencies of Lithgow and/or Isoda. Nowhere within Ishikawa, et al. or Hidaka, et al. is it disclosed, let alone suggested, that a non-conducting element is disposed between the columnar element and the dielectric element as required by independent claim 3.

Combining Fukazawa with the teachings of Lithgow, Isoda, Ishikawa, et al. and/or Hidaka, et al., would not yield the present invention as defined in independent claim 3. Although Fukazawa discloses a gap 9 between the columnar element and the dielectric element, nowhere within Fukazawa is it even remotely suggested that the thickness of conductor layers and the thickness of dielectric layers on an inner conductor are based on the non-conducting element as required by independent claim 3.

Therefore, even if one were to combine the teachings of the cited references, one would not arrive at the present invention as defined in independent claim 3. Accordingly, it is respectfully submitted that independent claim 3 patentably distinguishes over the art of record.

Claim 6 depends directly from independent claim 3 and includes all of the limitations found therein as well as additional limitations which, in combination with the limitations of independent claim 3, are neither disclosed nor suggested in the prior art of record. Accordingly, claim 6 is likewise patentable.

Claims 8 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lithgow or Isoda in view of Ishikawa, et al. or Hidaka, et al., and further in view of Tada, et al. Applicants respectfully traverse this rejection.

Similar to independent claim 3, each of independent claims 8 and 10-12 require that a non-conducting element is disposed between the columnar element and the dielectric element, and that the thickness of the conductor layers and the thickness of the dielectric layers are based on the non-conducting element.

As described above, neither Lithgow, Isoda, Ishikawa, et al., nor Hidaka, et al. teach or suggest disposing a non-conducting element between a columnar element and a dielectric element, let alone determining the thickness of the conductor layers and the thickness of the dielectric layers based on the non-conducting element.

Tada, et al. does not remedy any of the deficiencies of the art of record. Nowhere within Tada, et al. is it disclosed, let alone suggested, to place a non-conducting element between a columnar element and dielectric element, let alone base the thickness of the conductor layers and the thickness of the dielectric layers on the non-conducting element as required by independent claims 8 and 10-12.

Therefore, even if one were to combine the teachings of Lithgow, Isoda, Ishikawa, et al., Hidaka, et al. and/or Tada, et al., one would not arrive at the present invention as defined in independent claims 8 and 10-12. Accordingly, it is respectfully

submitted that independent claims 8 and 10-12 patentably distinguish over the art of record, and reconsideration and withdrawal of this rejection is respectfully requested.

Claims 3, 6-8, 10-12 and 21 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of co-pending Application Serial No. 09/707,264 in view of Lithgow or Isoda. This rejection is deemed moot with respect to claims 7 and 21 due to their cancellation. Applicants respectfully request that this provisional obviousness-type double patenting rejection be held in abeyance until final resolution of the other issues remaining in this application.

Claims 3, 6-8, 10-12 and 21 have been provisionally rejected under 35 U.S.C. § 103(a) as being obvious over co-pending Application Serial No. 09/707,264. This rejection, however, is improper.

Effective November 29, 1999, 35 U.S.C. § 103(c) provides that subject matter developed by another which qualifies as prior art only under one or more of subsection 35 U.S.C. § 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under Section 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made or subject to an obligation of assignment to the same person.

The present application and co-pending Application Serial No. 09/707,264 are both assigned to Murata Manufacturing Co., Ltd. As stated on page 8 of the Office Action, co-pending Application Serial No. 09/707,264 would constitute prior art only under 35 U.S.C. § 102(e) if published or patented. Therefore, since co-pending Application Serial No. 09/707,264 is a Section 102(e) reference, and both the present application and co-pending Application Serial No. 09/707,264 were commonly owned at the time the present invention was made, co-pending Application Serial No. 09/707,264

cannot be considered in determining obviousness of the present application under §103. Accordingly, reconsideration and withdrawal of this provisional §103 rejection is respectfully requested.

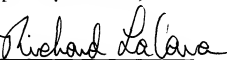
Claim 4 was previously withdrawn from consideration in a species restriction requirement. As claim 4 depends from allowable generic claim 3, it is respectfully requested that claim 4 be considered and allowed along with the other pending claims in the present application.

In addition, Applicants filed an Information Disclosure Statement on June 3, 2003 in the present application. Applicants respectfully request that the Examiner return an initialed copy of the PTO/SB/08 form with the next action on this application so as to indicate that the references cited in the Information Disclosure Statement have been considered against the pending claims.

In view of the foregoing, favorable consideration of the amendments to claims 3, 8 and 10-12, and allowance of the present application with claims 3, 4, 6, 8 and 10-12 is respectfully and earnestly solicited.

Dated: August 7, 2003

Respectfully submitted,

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